

Application No. 10/750,016
Response dated February 16, 2007
Reply to Office Action of November 17, 2006

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Remarks

Claims 1, 3-9, 13, and 14 are presented for consideration. Claims 10-12 have been withdrawn and claims 2 and 15-20 have been canceled. Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

VanGompel, Herrin, Coenen '741, and optionally Milner do not teach or suggest each and every element of the claimed invention.

Claims 1, 2, 7, and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over U.S. Patent No. 6,336,922 issued January 8, 2002, to VanGompel et al. (hereinafter "VanGompel") in view of U.S. Patent No. 5,308,345 issued May 3, 1994, to Herrin (hereinafter "Herrin"), and further in view of PCT Publication No. WO 02/13741 by Coenen et al. (hereinafter "Coenen '741") and optionally in view of U.S. Patent Publication No. 2001/0042591 by Milner et al. (hereinafter "Milner"). Claim 2 was canceled in a previous Amendment and will not be addressed herein. Applicants respectfully submit that the Examiner's rejection of claims 1, 7, and 13 is improper and should be reversed.

To establish a *Prima Facie* case of obviousness, the Examiner must meet three basic criteria: (1) the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) the Examiner must show a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

Applicants submit that the Examiner has provided no suggestion or motivation as to why one of ordinary skill in the art would combine the teachings of VanGompel, Herrin, Coenen '741, and optionally Milner as suggested by the Examiner. That is, the Examiner has not provided any reasoning why one of ordinary skill in the art would combine the teachings of VanGompel (for an absorbent article with an elastic member, as suggested by the Examiner) with the teachings of Herrin (for a method for applying an elastic member, as suggested by the Examiner), and further with the teachings of Coenen '741 (for the formation of a line of weakness, as suggested by the

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Examiner). Instead, the Examiner asserts in piecemeal fashion why one would look from one reference to another, but does not provide any motivation or suggestion why one would collectively assemble these references to arrive at the present invention. In fact, the Examiner appears to acknowledge as much. Whereas the Examiner previously stated that VanGompel and Herrin together are silent as to cutting an elastic material to define a leading edge of an elastic member and separating the elastic material at a line of weakness into discrete elastic members (see page 6-7 of the Office Action mailed October 5, 2005), the Examiner has now apparently found such teachings in Herrin, allowing the Examiner to eliminate the controversial Ujimoto as a reference. The Examiner also attempted to fill in a gap by that Office Action by adding the teachings of Milner to the teachings of Coenen '741 on page 6-7 of the Office Action mailed October 5, 2005, because Coenen '741 is directed to the formation of a leg elastic and the Examiner needed an example of a reference discussing waist elastic.

As an example, a leap in logic is applied to the alleged motivation in adding Coenen '741 to the combination. The Examiner states that applying Coenen '741's process of forming a line of weakness prior to cutting an elastic piece "makes the separation of the elastic material web easier," implying that the teachings of Coenen '741 would make the processes of Herrin easier. Coenen '741 does not do this. Coenen '741 merely states at page 10, lines 22-24 that cutting a web at a line of weakness is easier than cutting the same web without the line of weakness, an apparently logical statement. Coenen '741 does not teach that the separation process of forming a line of weakness and then separately cutting the web at that line of weakness (Coenen '741's process) is easier than the separation process of merely cutting the web once (Herrin's process). Further, the Examiner has not stated where in Herrin's process forming a line of weakness should be added to make the process easier, or especially how adding an additional step with its requisite equipment and controls will simplify the Herrin process.

The Examiner asks us to ignore the first step of forming the line of weakness to look only at the comparison between cutting at a line of weakness and cutting without a line of weakness. To make out the motivation necessary to combine the references (i.e., to make the separation process easier), the Examiner needs Coenen '741 to state that the entire two-step process of forming a line of weakness and then cutting at that line of weakness is easier than simply cutting. Coenen '741 does not do this. As a result, there can be no motivation to look to Coenen '741 to make easier the process of Herrin and these references are not properly combinable. The Examiner is left with the dilemma of needing to pick pieces of Coenen '741 and Herrin to assemble part of the Applicants'

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claimed invention, yet having no apparent motivation, teaching, or suggestion to combine the references.

Indeed, it appears that the Examiner is improperly relying on hindsight based on the teachings of the present invention to suggest that one of ordinary skill in the art would be motivated to combine the above references in the manner suggested. That is, it appears that the Examiner is improperly utilizing Applicants' disclosure as a road map for picking and choosing amongst a universe of potential configurations to arrive at the distinctive changes and modifications needed to further derive Applicants' claimed invention. In particular, the Examiner relies on three, and optionally a fourth reference to arrive at the present invention. Applicants respectfully submit that the motivation for why one of ordinary skill in the art would select just the right element required by the Examiner from three and perhaps four different references to arrive at the present invention has not been provided. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For at least these reasons, Applicants submit that claim 1 is patentable over the combination of VanGompel, Herrin, Coenen '741, and optionally Milner. Moreover, claims 3-9, 13, and 14, which all eventually depend from allowable independent claim 1, are likewise patentable over the combination of VanGompel, Herrin, Coenen '741, and optionally Milner.

With respect to claim 13, the Examiner states that Herrin's exit point 94 is wider than half (50%) the width of Herrin's entry point 92. While this certainly appears to be true, it is not clear why the Examiner would point that out or how that teaches claim 13's elongation of "said inboard portion of said elastic member at least 50%." By the Examiner's statement, the exit point could be smaller than the entry point; this would not teach or suggest the subject matter of claim 13.

VanGompel, Herrin, Coenen '741, and Milner in view of Coenen '151 do not teach or suggest each and every element of the claimed invention.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over VanGompel, Herrin, Coenen '741, and Milner in view of U.S. Patent No. 4,642,151 issued February 10, 1987, to Coenen (hereinafter "Coenen '151"). Applicants respectfully submit that the Examiner's rejection is improper and should be reversed.

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Claim 3 is patentable because it depends from patentable independent claim 1, as described above.

Alternatively, and in addition to the remarks made above with respect to the inappropriateness of combining VanGompel, Herrin, Coenen '741, and Milner, there is no motivation to add Coenen '151 to the mix, especially in that Coenen '151 does not teach what the Examiner needs it to teach, nor what the Examiner says that it teaches. The Examiner looks to Coenen '151 to teach the application of adhesive to an elastic material web as required, *inter alia*, by claim 3. But Coenen '151 does not teach applying an adhesive to an elastic material web. When col. 3, line 65 to col. 4, line 8, as cited by the Examiner, is read with col. 3, lines 44-64, it becomes apparent that Coenen '151 teaches applying adhesive to a piece of elastic (i.e., one that has already been cut) just prior to its attachment to a base material. Coenen '151 does not teach how to apply adhesive to a web of elastic material, remembering that the adhesive-coated elastic material web will then need to be cut and perhaps elongated. Neither Coenen '151 nor any of the other references, alone or in combination, teach or suggest the subject matter of claim 3.

For at least these reasons, Applicants submit that claim 3 is patentable over the combination of VanGompel, Herrin, Coenen '741, and Milner in view of Coenen '151. Moreover, claims 4-6, which all depend from allowable claim 3, are likewise patentable over the combination of VanGompel, Herrin, Coenen '741, and Milner in view of Coenen '151.

VanGompel, Herrin, Coenen '741, Milner, and Coenen '151 in view of Ujimoto do not teach or suggest each and every element of the claimed invention.

Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over VanGompel, Herrin, Coenen '741, Milner, and Coenen '151 in view of U.S. Patent No. 4,943,340 issued July 24, 1990, to Ujimoto et al. (hereinafter "Ujimoto"). Applicants respectfully submit that the Examiner's rejection is improper and should be reversed.

Claims 4-6 are patentable because they eventually depend from patentable independent claim 1, as described above, and also because they depend from patentable dependent claim 3, as described above.

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Alternatively, and in addition to the remarks made above with respect to the inappropriateness of combining VanGompel, Herrin, Coenen '741, Milner, and Coenen '151, there is no motivation to add Ujimoto to the mix, especially in that Ujimoto does not teach what the Examiner needs it to teach, nor what the Examiner says that it teaches. The Examiner looks to Ujimoto to teach various methods for applying adhesive to an elastic material web as required, *inter alia*, by claims 4-6. But Ujimoto does not teach applying an adhesive to an elastic material web as required by these claims. Ujimoto at col. 4, lines 50-51 states that an adhesive coating may be applied in a continuous, intermittent, or dotted form. Ujimoto appears to demonstrate "continuous" in Fig. 2, but "intermittent" and "dotted" are neither defined nor illustrated. In addition, no teaching is given with respect to the conditions under which "intermittent" and "dotted" may be defined or used. And yet the Examiner extracts "rectilinear" and "registered with said leading edge and said trailing edge" from the mere mention of "intermittent" and "dotted." The Examiner has shown no teaching or suggestion that would make obvious claims 4 and 5. With respect to claim 6, the Examiner states that Ujimoto discloses a method wherein the adhesive does not contact the pair of wheels as required, *inter alia*, by claim 6. It is not clear what the Examiner means as Ujimoto has no pair of wheels that the adhesive could contact or avoid. As such, neither Ujimoto nor any of the other references, alone or in combination, teach or suggest the subject matter of claims 4-6.

For at least these reasons, Applicants submit that claims 4-6 are patentable over the combination of VanGompel, Herrin, Coenen '741, Milner, and Coenen '151 in view of Ujimoto.

VanGompel, Herrin, Coenen '741, and Milner in view of Elsberg and Blenke do not teach or suggest each and every element of the claimed invention.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over VanGompel, Herrin, Coenen '741, and Milner in view of U.S. Patent No. 6,287,287 issued September 11, 2001, to Elsberg (hereinafter "Elsberg") and in view of U.S. Patent No. 6,022,430 issued February 8, 2000, to Blenke et al. (hereinafter "Blenke"). Applicants respectfully submit that the Examiner's rejection is improper and should be reversed.

Claim 8 is patentable because it depends from patentable independent claim 1, as described above.

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Alternatively, and in addition to the remarks made above with respect to the inappropriateness of combining VanGompel, Herrin, Coenen '741, and Milner, there is no motivation to add Elsberg and Blenke to the mix. It appears that the Examiner is improperly relying on hindsight based on the teachings of the present invention to suggest that one of ordinary skill in the art would be motivated to combine the above references in the manner suggested. That is, it appears that the Examiner is improperly utilizing Applicants' disclosure as a road map for picking and choosing amongst a universe of potential configurations to arrive at the distinctive changes and modifications needed to further derive Applicants' claimed invention. In particular, the Examiner relies on six references to arrive at the present invention. Applicants respectfully submit that the motivation for why one of ordinary skill in the art would select just the right element required by the Examiner from six different references to arrive at the present invention has not been provided. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For at least these reasons, Applicants submit that claim 8 is patentable over the combination of VanGompel, Herrin, Coenen '741, Milner, Elsberg, and Blenke.

VanGompel, Herrin, Coenen '741, and Milner in view of Ruscher do not teach or suggest each and every element of the claimed invention.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over VanGompel, Herrin, Coenen '741, and Milner in view of U.S. Patent No. 5,560,793 issued October 1, 1996, to Ruscher et al. (hereinafter "Ruscher"). Applicants respectfully submit that the Examiner's rejection is improper and should be reversed.

Claim 14 is patentable because it depends from patentable independent claim 1, as described above.

Alternatively, and in addition to the remarks made above with respect to the inappropriateness of combining VanGompel, Herrin, Coenen '741, and Milner, there is no motivation to add Ruscher to the mix. Contrary to the Examiner's assertion, Ruscher does not disclose applying an elastic member to an article web material. Ruscher describes an elastic web, but not individual elastic members. In addition, the sole motivation cited by the Examiner to add Ruscher is Ruscher's

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mention of sizing the internal diameter of a wheel to accommodate passing a web therethrough. As none of the other references disclose the structure of or the need for passing a web through a wheel, there can be no motivation to turn to Ruscher to add such a structure, and therefore no motivation to add the ancillary wheel sizing. It again appears that the Examiner is improperly relying on hindsight based on the teachings of the present invention to suggest that one of ordinary skill in the art would be motivated to combine the above references in the manner suggested. That is, it appears that the Examiner is improperly utilizing Applicants' disclosure as a road map for picking and choosing amongst a universe of potential configurations to arrive at the distinctive changes and modifications needed to further derive Applicants' claimed invention. In particular, the Examiner relies on five references to arrive at the present invention. Applicants respectfully submit that the motivation for why one of ordinary skill in the art would select just the right element required by the Examiner from five different references to arrive at the present invention has not been provided. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For at least these reasons, Applicants submit that claim 14 is patentable over the combination of VanGompel, Herrin, Coenen '741, Milner, and Ruscher.

The Applicants note that the Examiner has provided no basis for the apparent rejection of claim 9. With no rejection to address, the Applicants aver that claim 9 is patentable because it depends from patentable independent claim 1, as described above.

In conclusion, and in view of the amendments and remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable consideration and the timely allowance of pending claims 1, 3-9, 13, and 14. Further, since Applicants believe claim 1 to be generic, Applicants request the reintroduction into prosecution and allowance of claims 10-12.

Please charge any prosecution fees that are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

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